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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,525	02/17/1999	SHINICHI SATO	11301-1480	1170

7590

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER


1711

DATE MAILED: 08/09/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/242,525	Applicant(s) Sato et al.	
Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 31, 2002
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-58 is/are pending in the application.
- 4a) Of the above, claim(s) 49-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 - 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
 - a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3,7,17
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1711

1. In accordance with applicants' election of species and the statement of the claims readable thereon, set forth within applicants' responses, filed May 17, 2001 and January 28, 2002, claims 46-48 have been examined with respect to species (a-1) and (a-2), containing alkoxy groups and primary amine groups; species (b), an α,β -unsaturated carbonyl compound; and species (c), a polyol. In accordance with Office practice, species (a-1) was selected by the examiner for examination after a prior art search failed to reveal relevant art pertaining to applicants' elected species (a-2).
2. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 47 to state that compound (a-2) has one primary amino group. This definition fails to agree with other definitions of (a-2) within the claims and specification. Elsewhere, species (a-2) has at least two primary amine groups or at least one primary amine group and at least one secondary amine group. Similarly, the definition of (a-2) within claim 47 agrees with the definition of (a-1) elsewhere in the claims and specification. Given applicants' reliance on several variables throughout the specification, it is imperative that the definitions of the variables be consistent to prevent ambiguity and confusion.

3. Claims 46-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

Art Unit: 1711

art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to specify the type of molecular weights (weight average or number average) for product (C) and compound (f) or how the molecular weights have been determined.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Zwiener et al. ('955).

Patentees disclose the production of a moisture curable urethane composition derived from the reaction of a polyurethane prepolymer, corresponding to applicants' product (B), with a reaction product of amino-alkyl alkoxysilanes and maleic or fumaric acid esters, corresponding to applicants' product (A). The amino-alkyl alkoxysilanes correspond to applicants' compound (a-1) (claim 46) or applicants' compound (a-2) (claim 47). See abstract; column 1, lines 64+; column 2; and examples 6-9.

Any inquiry concerning this communication should be directed to R. Sargent at telephone number (703) 308-2982.

R. Sargent
August 7, 2002


RABON SERGENT
PRIMARY EXAMINER